

**REMARKS**

In view of the following remarks, Applicant respectfully requests reconsideration and allowance of the subject application. This amendment is believed to be fully responsive to all issues raised in the 08/08/2005 Office Action.

**Claims Amendments**

Claims 1—15, 31—45 and 61—75 are original and 91—109 were previously presented.

**The §103 Rejections**

The Applicant submits that the Office has failed to establish a *prima facie* case of obviousness and, in view of the comments below, respectfully traverses the Office's rejections. However, before discussing the substance of the Office's rejections, a section entitled "The §103 Standard" is provided and will be used in addressing the Office's rejections. Following this section, sections entitled "The Kim Reference" and "The How-To Reference" are provided, which describe the disclosure and teachings of these two references.

**The §103 Standard**

To establish a *prima facie* case of obviousness, three basic criteria *must* be met. MPEP § 2142. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Finally, the prior art reference (or references when combined)

1 must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 180  
2 USPQ 580 (CCPA 1974).

3 Hence, when patentability turns on the question of obviousness, the search  
4 for, and analysis of, the prior art includes evidence relevant to the finding of  
5 whether there is a teaching, motivation, or suggestion to select and combine or  
6 modify the references relied on as evidence of obviousness. The need for  
7 specificity pervades this authority. See, e.g., *In re Kotzab*, 217 F.3d 1365, 1371,  
8 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to  
9 the reason the skilled artisan, with no knowledge of the claimed invention, would  
10 have selected these components for combination in the manner claimed").

### 11 The Kim Reference

12 The Kim Reference teaches a browser adapted to put advertisements onto  
13 the screen. In particular, Kim teaches an application which runs as part of, or in  
14 conjunction with, a browser program. The application periodically downloads  
15 advertisements (ads) when the browser is substantially idle and stores them locally  
16 (Abstract; lines 4—7). Kim detects transition from a first web page to a second  
17 web page, and takes advantage of the time during which it takes the second  
18 webpage to download (0045; lines 1—2) to display (0077; lines 5—10) the locally  
19 stored ads. Note that the ad may occupy the full window of the browser (0078;  
20 lines 2—5), a partial window, or may be positioned outside the window (0078;  
21 lines 10—13).

22 Therefore, Kim teaches browser technology configured *for the display of*  
23 *ads*, either in the full browser window, a part of the browser window or in a new  
24 window. The ads are displayed in response to a change from the first webpage to  
25 the second webpage. However—as the Office Action points out and the Applicant

1 agrees—Kim does not disclose ignoring requests for a second window where the  
2 request was not initiated in response to user action.

3 Kim mentions pop-up ads in four paragraphs. In 0009, Kim mentions that  
4 pop-up ads may result in “consumers (becoming) upset and bothered.” The  
5 context for this statement is that pop-up ads are not a beneficial method for  
6 advertising and that advertisers should advertise according to the methods of Kim.  
7 The context of this statement is *not* that Kim is considering ways to fight pop-up  
8 ads. Kim is only saying that Kim’s way of advertising is a better way of  
9 advertising. In 0038, Kim again indicates that pop-up ads are not an effective  
10 advertising tool. In 0123 Kim mentions that pop-up ads can block the user’s view,  
11 and in 0145, Kim mentions the interference pop-up ads can cause. However,  
12 nothing in Kim suggests that Kim is considering “fighting” pop-up ads; only that  
13 Kim considers them to be an inferior method of advertising. Kim is in fact very  
14 pro-advertising, having disclosed a system and method for advertising.  
15 Accordingly, nothing in Kim suggests that Kim is considering the addition of an  
16 apparatus or method of stopping pop-up ads.

### 17 The “How-To” Reference

18 In contrast to the browser software seen in Kim, the How-To reference  
19 teaches *changing the code that comprises a website* to prevent the host of the  
20 website from inserting successful pop-up ads into responses sent by the website to  
21 hits made on the website.

22 In particular, the How-To reference discloses a number of strategies by  
23 which a website owner can change a website to prevent display of advertisements  
24 that the host server of the website inserts. Accordingly, the How-To reference  
25

1 does not disclose browser technology that ignores or follows instructions for  
2 opening a second window. Instead, How-To discloses website modifications.

3 In general, the background and teachings of How-To may be understood by  
4 the following exemplary scenario:

- 5 1. A Website Admin writes code to configure a Website.
- 6 2. The Website Admin hires Host (an internet service provider (ISP))  
7 to physically host the Website.
- 8 3. Website Admin notices that Host is injecting Host's pop-up ads into  
9 the responses to "hits" on Admin's website. Website Admin is  
10 upset, since Website viewers may avoid Website due to Host's  
11 advertising.
- 12 4. Website Admin investigates and realizes that Host is employing any  
13 of several methods to introduce the ads. Accordingly, Website  
14 Admin must find out (1) what the Host is doing to introduce the pop-  
15 up ads, and (2) consult How-To for indicated remedy. For example  
16 to kill pop-up as they appear, Admin must check to see what Host  
17 has named the window (How-To, middle of page 3 of 6).
- 18 5. Website Admin alters the code in Website (according to How-To's  
19 instructions) to nullify Host's strategy of introducing pop-up ads into  
20 Website Admin's Website.

21 Thus, How-To is adapted for use on a website to thwart ads injected by the  
22 website's host. How-To instructs that the host may employ any of many strategies  
23 to insert pop-up ads—accordingly, How-To provides six pages of possible  
24 solutions. *None of the solutions always works. The administrator of the website*  
25

1 *must find the solution that works in view of what the host is doing. The*  
2 *administrator must then change the code of the website.*

3 While How-To's technology works well for website owners, it does not  
4 combine with browser technology in a successful manner.

### 5 **Traversal of the §103 Rejections**

6 Claims 1—15, 31—45 and 61—75 are 91—109 were rejected under 35  
7 U.S.C. section 103(a) as being anticipated by U.S. application 2002/0052925  
8 (“Kim”) and the How-To document (How-To). The Applicant respectfully  
9 traverses the rejection of claims 1—15, 31—45 and 61—75 are 91—109.

10 **Claim 1** recites a computer system having a graphical user interface  
11 including a display and a user interface selection device, a method of maintaining  
12 a single window interface, comprising:

- 13
- 14 • receiving a request to open a second browser window while a first  
browser window is displayed;
- 15 • **ignoring the request if the request was not initiated in response  
to a user action;** and
- 16 • opening the second browser window if the request was initiated in  
response to a user action.
- 17

18 **Claims 31, 61, and 91** include similar recitations.

### 19 **The Technology of How-To Cannot be Adapted for Use in a Browser**

20 As seen above, to justify the combination of two references in making a  
21 section 103 rejection, there must be a reasonable expectation of success. *In re*  
22 *Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case,  
23 the technologies of Kim and How-To can not be combined. *That is, there can and*  
24  
25

1 *will be no success from such a combination.* A number of factors prevent  
2 application of How-To's technology to browsers.

3 Technical difficulties, such as unresolved issues regarding application of  
4 How-To's website-based technology to a browser, prevent How-To from being  
5 combined with Kim or any other browser technology. For example, the references  
6 do not disclose how the browser can be configured to choose from among How-  
7 To's strategies, when How-To fails to provide an algorithm by which a correct  
8 strategy can be immediately selected. How-To fails to disclose how someone  
9 without access to a "clean" version of the website code (i.e. website code  
10 unpolluted by ads) can know which part of the code downloaded from the website  
11 can safely be commented out. How-To fails to disclose how someone without  
12 access to a "clean" version of the website code can know which window names  
13 are those of valid website windows, and which window names are those of ads.  
14 How-To fails to disclose how someone without access to a "clean" version of the  
15 website code can know whether it is safe to apply some of How-To's tricks, such  
16 as disabling JavaScript. Therefore, the combination of Kim's technology with  
17 How-To's technology has little expectation of success.

18 How-To provides ten or more strategies for thwarting ads, and assumes that  
19 a website owner can figure out which strategy is appropriate for the website in  
20 question. How-To is silent about how a browser could block ads. For example,  
21 no automated method is disclosed of quickly figuring out what strategy should be  
22 applied to any given website. How-To implies that the website owner will have to  
23 investigate and do some trial and error work to determine what the host is doing to  
24 insert ads, and then select an appropriate fix from How-To's technology.  
25 However, Kim does not, and How-To does not, suggest a method by which a

1 browser could know which of How-To's fixes to apply for use with an arbitrary  
2 website visited by the browser. Thus, while How-To works fine for the website  
3 owner who can patiently figure out which of How-To's fixes to apply, How-To's  
4 technology is not adapted for use with a browser, since How-To provides no  
5 automated mechanism which explains which fix should be applied by the browser  
6 when receiving information from any given website.

7 Several of How-To's strategies involve "commenting out" parts of the code  
8 sent to the browser. That is, statements intended to create ads are turned into  
9 ineffective "comments" by the changes made to the code by the How-To  
10 teachings. This assumes knowledge of the website's code, and the ability to  
11 distinguish the website's non-advertisement code from advertisement code  
12 inserted by the host. The website owner has this knowledge, and is in a position to  
13 distinguish the ad-related code. The browser has no way of distinguishing website  
14 code from ad code. The website owner is familiar with the website code, and is  
15 able to insert the <noscript> or <!--(comment) tags suggested by How-To (How-  
16 To, page 1) in the correct locations. However, How-To is silent about how a  
17 browser could possibly know where to insert the comment tags. For example, the  
18 website may have a "good" window and a pop-up ad window, and the browser  
19 (not having the information available to How-To's audience of website owners)  
20 would not know which was which. Thus, while a website owner would know  
21 which window to comment out, the browser could not possibly know. Thus, while  
22 How-To's technology works fine for the website owner, it would not work for a  
23 browser.

24 Several of How-To's fixes involve learning the name of pop-up ad  
25 windows, and then using that information to thwart opening of the pop-up ad

1 window. Learning the window name is possible for the website owner, who can  
2 experiment some, and learn the name(s) of windows that are not part of the  
3 website (and are therefore ads). However, How-To provides no information on  
4 how a browser could determine—between two window names within the code  
5 sent by the website—which was the pop-up ad window and which window was  
6 part of the website. Thus, while the owner of the website would know the name of  
7 the website's windows (and thus be able to distinguish the names of the ad  
8 windows) the browser could not possibly have this information. Thus, while  
9 How-To's technology works fine for the website owner, it would not work for a  
10 browser.

11 Several of How-To's techniques require some knowledge of the website's  
12 code in order to know if a given fix can be safely used. For example, according to  
13 one of How-To strategies, pop-up ads may be killed by turning off JavaScript.  
14 However, this is only applicable where the website itself does not use JavaScript.  
15 How-To—whose audience includes website owners—assumes that 'Can  
16 JavaScript be turned off without impacting the website?' is an easy question.  
17 However, How-To does not make it clear how a browser—that may be  
18 downloading code for the first time from a website—could answer such a  
19 question. Thus, while How-To's technology works fine for the website owner, it  
20 would not work for a browser.

21 Thus, while How-To capably discloses how a website owner can block ads,  
22 How-To fails to address the subject of how a browser can block ads. In fact, a  
23 number of unresolved technical issues indicate that combination of the How-To  
24 reference with Kim should not be expected to result in success. Accordingly, the  
25 combination of How-To and Kim is improper.



1       The Patent Office suggests that since How-To teaches blocking ads that  
2       were not requested, that How-To's technology could be combined with the  
3       browser of Kim to yield a combined technology disclosing the recited claim.

4       The Applicant respectfully disagrees. As shown above, the combination of  
5       How-To and Kim would raise substantial unresolved technical issues, and would  
6       be inoperative. This is partly the case because How-To discloses formatting data  
7       for transmission to a web browser, while Kim discloses operation of a web  
8       browser.

9       For example, one or more of How-To's solutions may be applicable to  
10      removing ads from a web administrator's website, wherein the administrator  
11      knows the website's code (in its state unpolluted by ads). However, How-To does  
12      not resolve technical issues raised by the need to remove ads from any arbitrary  
13      website wherein access to the website's code unpolluted by ads is not known.

14       **Combination of Kim & How-To Represents Use of Hindsight by Office**

15      The combination of Kim and How-To represent impermissible use of  
16      hindsight by the Patent Office. In fact, nothing in Kim would suggest combination  
17      with How-To. Kim discloses aspects of browser technology. How-To discloses  
18      aspects of website software, particularly for use when the host tries to insert ads  
19      into responses to 'hits' on the websites pages. Because Kim discloses browser  
20      operations on a client, and because How-To discloses website operations on a  
21      server (host), there is no suggestion by either that combination with the other is  
22      desirable or even possible. Moreover, as seen above, since Kim and How-To  
23      represent technologies that cannot be combined without resolution of many  
24      technical issues, their combination is not foreseeable, and would therefore  
25      represent hindsight.

1        **“Pro ad” Kim and “Anti ad” How-To Teach Away from Combination**

2        Kim and How-To teach away from their combination based in part on their  
3        differences with respect to advertising. Kim is “pro ad” and How-To is “anti ad.”  
4        An inventor would not think to combine such references. Kim discloses  
5        technology adapted display ad for viewing by a browser user. In contrast, How-  
6        To discloses technology adapted to package website responses in a way that  
7        prevents pop-up ads. Accordingly, it is not foreseeable that an inventor would  
8        combine such a “pro ad” reference with such an “anti ad” reference.

9        **“Browser/Client” Kim and “Website/Server” How-To Teach Away**  
10       **from Combination**

11       Kim and How-To teach away from their combination based in part on their  
12       differences in platform. Kim is intended as a browser and/or browser  
13       enhancement operable on a client. In contrast, How-To is configured for operation  
14       on a website, located on a server/host. An inventor would not think to combine  
15       such references. *The executable code for the references is not configurable to*  
16       *operate on the same computer.* Accordingly, it is not foreseeable that an inventor  
17       would combine a ‘client-side browser’ reference with a ‘server-side website’  
18       reference.

19       For these reasons and others, Kim, adapted with How-To’s technology,  
20       would be non-functional, and the combination of Kim and How-To is improper.  
21       Accordingly, the Applicant respectfully requests that the rejection of claims 1, 31,  
22       61 and 91 be removed.

23       **Claim 9** recites a computer system having a graphical user interface  
24       including a display and a user interface selection device, a method of maintaining  
25       a single window interface, wherein the method further comprises:

- suppressing a request to open a dialog box until a browser window associated with the request to open the dialog box is displayed.

**Claims 39, 69, and 99** include similar recitations.

The Patent Office cites Kim at paragraph 77, lines 8—14. However, the cited portions of the Kim reference fail to disclose the use of a dialog box generally, or suppressing a request to open a dialog box particularly. In contrast, the cited passage discloses showing an ad if the download time exceeds a threshold time. Therefore, the elements recited by the claims are not shown, and the rejection is improper. Accordingly, the Applicant respectfully requests that the rejection be removed from claims 11, 41, 71 and 101.

**Claim 11** recites a computer system having a graphical user interface including a display and a user interface selection device, a method of maintaining a single window interface, wherein the method further comprises:

- receiving a request to close a browser window;
- closing the browser window if another browser window is open; and
- ignoring the request if no other browser window is open.

**Claims 41, 71, and 101** include similar recitations.

The Patent Office cites Kim at paragraph 77, lines 16—19. The cited portions of the Kim reference refer to detecting whether a webpage downloading time, which if exceeded, results presentation of an ad. After the ad is displayed for a contracted time, the ad is removed and the downloading page is displayed. This does not disclose, “receiving a request to close a browser window,” since no request is disclosed. It also does not disclose, “ignoring the request if no other

1 browser window is open,” since no ignoring is disclosed. Accordingly, the  
2 rejection is improper, and the Applicant respectfully requests that the rejection be  
3 removed from claims 11, 41, 71 and 101.

4 **Claim 12** recites a computer system having a graphical user interface  
5 including a display and a user interface selection device, a method of maintaining  
6 a single window interface, wherein the method further comprises:

- 7 • maintaining, in a browser history, a history of transitions between  
8 the first and second browser windows.

9  
10 **Claims 42, 72, and 102** include similar recitations.

11 The cited portions of the Kim reference refer to archiving *information*  
12 *content* (Kim, paragraph 0049). This is not the same as “maintaining a browser  
13 history,” *i.e.*, the list that instructs the browser which page to go to when the back  
14 and forward browser buttons are pressed. Accordingly, the rejection is improper,  
15 and the Applicant respectfully requests that the rejection be removed from claims  
16 12, 42, 72 and 102.

17 **Claim 13** recites a computer system having a graphical user interface  
18 including a display and a user interface selection device, a method of maintaining  
19 a single window interface, wherein the method further comprises:

- 20 • building the browser history from a history of a displayed browser  
21 window.

22  
23 **Claims 43, 73, and 103** include similar recitations.

1       The cited portions of the Kim reference refer to archiving *information*  
2 *content* (Kim, paragraph 0049). This is not the same as “building a browser  
3 history from a history of a displayed browser window.” Accordingly, the rejection  
4 is improper, and the Applicant respectfully requests that the rejection be removed  
5 from claims 12, 43, 73 and 103.

6       **Claims 2—15, 32—45, 62—75 and 92—105**

7       These claims are allowable due to their dependency on claims that are  
8 allowable for the reasons seen above, as well as for reasons associated with the  
9 elements recited in each claim.

10       **Claims 106—109**

11       Claims 106—109 are allowable as being dependent on claims allowable for  
12 the reasons seen above, as well as for reasons associated with the elements recited  
13 in each claim. In particular, claims 106—109 recite an example of how “in  
14 response to user action” and “not in response to user action” can be determined.  
15 Neither Kim nor How-To evaluate “if the request” was or was not initiated “in  
16 response to a user action.” Accordingly, neither Kim nor How-To disclose the  
17 elements recited in claims 106—109, which are allowable for at least this reason.

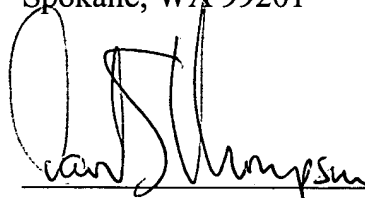
18       **Conclusion**

19       The technology of the How-To is not adapted for combination with the Kim  
20 reference. While How-To may disclose technology that is well adapted to modify  
21 websites in a manner that thwarts ads, How-To fails to disclose how this  
22 technology could be adapted for use in browsers. Therefore, a combination of  
23 Kim’s technology and How-To’s technology would be non-functional, in part due  
24 to large and unresolved technical issues. Additionally, combination of Kim and  
25 How-To is by way of hindsight, and fails to address technical issues that prevent

1 their combination. And further, Kim and How-To teach away from combination  
2 for at least two reasons: Kim is "pro ad," while How-To is "anti ad"; additionally,  
3 Kim is client-base, while How-To is server-based. Accordingly, the combination  
4 of Kim and How-To is improper. Therefore, the Applicant respectfully requests  
5 that the rejection to claims 1—15, 31—45, 61—75 and 91—109 be removed.  
6 Should any issue remain that prevents immediate issuance of the application, the  
7 Examiner is encouraged to contact the undersigned attorney to discuss the  
8 unresolved issue.

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12  
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14

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